



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,502	10/15/2003	Cropper S. Michael	END5008USCIP1	9047
27777	7590	08/09/2007		
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER ANDERSON, MICHAEL J	
			ART UNIT 3767	PAPER NUMBER
			MAIL DATE 08/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

H

Office Action Summary	Application No. 10/687,502	Applicant(s) MICHAEL ET AL.	
	Examiner Michael J. Anderson	Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/4/2006 and 10/22/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The references have been considered, and will be listed on any patent resulting from this application since they were provided on a separate list in the Information Disclosure Statement (IDS) Form PTO/SB/08 in compliance with 37 CFR 1.98(a)(1).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Ritchart (US patent No. 5,209,737) (Ritchart).

With regard to claims 1, 11 and 19, Ritchart discloses (figures 1-11) a trocar for performing a procedure on a patient, said trocar (10) comprising: a. a hollow cannula (22) having a distal end and a proximal end; b. a housing (28) having a distal end attached to said proximal end of said cannula and a proximal end having a wall attached thereto, said wall having an aperture therethrough (figure 10); c. a seal assembly (36, 40, 50, 54) disposed within said housing comprising a plurality of layered elastomeric members forming conical shape (figure 2-4; column 4, lines 14-27; column 6, lines 33-42).

With regard to claim 2, 12 and 20 Ritchart discloses the trocar according to claim 1, 11 and 19 and further discloses wherein said plurality of layered elastomeric members has a semi-circular profile (column 3, line 48, column 4, lines 5-25).

With regard to claim 3, 13 and 21 Ritchart discloses the trocar according to claim 2, 12, and 20 and further discloses wherein said layered elastomeric layers have a circumference of about 180 to 270 degrees (82, column 4, lines 50-55).

With regard to claim 4, 14 and 22, Ritchart discloses the trocar according to claim 1, 11 and 19 and further discloses wherein said seal assembly includes a first and second rigid rings, wherein said layered elastomeric members are disposed between and are abutting against said rings (column 7, lines 27-33).

With regard to claim 5, Ritchart discloses the trocar according to claim 4 and further discloses wherein said elastomeric members comprise a proximal flange portion, and an inwardly extending portion extending distally therefrom, wherein said proximal flange portions are disposed between and are abutting against said rings (figures 6-10).

With regard to claim 6 and 15, Ritchart discloses the trocar according to claim 4 and 14 and further discloses wherein said seal assembly has an outer perimeter which is attached to a flotation means (column 7, lines 8-25).

With regard to claim 7, Ritchart discloses the trocar according to claim 1 and further discloses wherein said seal assembly includes a plurality of protectors disposed proximal to said elastomeric seal (figures 4 and 6).

With regard to claim 8 and 16, Ritchart discloses the trocar according to claim 1, and 11 and further discloses wherein said layered elastomeric members are disposed

Art Unit: 3767

such that there is a substantially centrally located aperture in said seal assembly (column 1, lines 63-68).

With regard to claim 9, 17 and 23, Ritchart discloses the trocar according to claim 1, 11 and 19 and further discloses wherein said plurality of elastomeric layers are woven together (figures 4 and 6).

With regard to claim 10, 18 and 24, Ritchart discloses the trocar according to claim 1, 11 and 19 and further discloses wherein said plurality of elastomeric layers have a non-planer shape prior to be assembled together (figures 4 and 6-9).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1-24 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-32 of copending Application No.

Art Unit: 3767

10/815356. Although the conflicting claims are not identical, they are not patentably distinct from each other because all claim the trocar device.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

References considered pertinent to Applicants' disclosure are listed on form PTO-892 of co-pending application 10/815,356. All references listed on form PTO-892 are cited in their entirety.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Anderson whose telephone number is (571) 272-2764. The examiner can normally be reached on M-F 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin C. Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3767

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael J Anderson
Examiner
Art Unit 3767

MJA
8/3/2007

KEVIN C. SIRMONS
SUPERVISORY PATENT EXAMINER

